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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,707	08/20/2003	Klaus-Juergen Pees	ACY33350-02	5127

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

PATEL, SUDHAKER B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/643,707	Applicant(s) PEES ET AL.	
	Examiner Sudhaker B. Patel, D.Sc.Tech.	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' communication paper dated 12/15/03 is acknowledged.

Status of the claims

1. Claims 1-6 are pending.

Claims 1-6 are rejected as being based upon a defective reissue oath or declaration under 37 CFR §§ 1.63 and 1.75. See MPEP§1414.

The reissue oath/declaration filed with this application is defective because:

(1). The Statement Under 37 CFR 3.73(B)/PTO Form SB/96(08-03) has the acceptance stamp dated 12/15/2003 by the Office. However, the above stated Form has blanks, and is missing the exact Telephone number & **date on which Director Wicke & Manager Heistracher who are authorized to act on behalf of the assignee executed it.**

(2). Reissue Application Declaration by the Assignee Form PTO/SB/52(03-02) fails to list the **exact Residence/ Mailing addresses for the inventors** of the instant application.

(3). Page 2 of Assignee Form PTO/SB/52(03-02) has been executed **by different persons than the authorized persons** stated above in (1)., namely, Dr. Koester and Dr. Stark.

(4). The oath or declaration must state whether the inventor is a sole or joint inventor of the invention claimed as required by 37 CFR 1.63(a). Note, the "Typed or Printed Names", and the word "joint " are missing in the document submitted by the applicants.

(5). The oath or declaration does not state that "all errors being corrected in the

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reissue application up to the time of the filing of the oath or declaration arose without any deceptive intention on the part of the applicant"(37 CFR 1.175(a) (2)) or language equivalent thereto.

A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP 602.01 and 602.02.

Additionally, the oath does not claim the relationship **and subject matter** among U.S. Application Serial NO. 08843323, filed 4/14/1997; PCT/US98/05615, filed 3/23/1998 and the issued U.S.P 6255309, and also, there is **no amendment** to add/correct the continuity data.

There is no actual claim for the priority date. **See rejections below.**

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office Action.

2. There is no amendment(s) for the exact corrections to be entered by the Office.
3. The original ribboned copy of the patent has not been surrendered. Therefore, either the original patent, or the statement as to loss or inaccessibility of the original patent, **must** be received before this reissue application can be allowed.

Priority

4. Applicants' claim for benefit of domestic priority of non-provisional U.S. Application Sr. NO. 08843323, filed 4/14/1997 has been mentioned in the above stated defective declaration, although it is not mentioned in the specification. Correction to specification is required.

Acknowledgement is made of the applicants' claim in the oath for foreign priority based on an application PCT/US/987/05615, filed 3/23/1998. It is noted, however, that applicants have not filed a certified copy of this application with the instant application.

However, benefit cannot be granted because of the lack of continuity. As applicants recognized, this is based on a lack of continuity with PCT/US/98/05615 filed 3/23/1998, and also with U. S. Application Sr. NO. 08843323, filed 4/14/1997. Thus, the relevant date remains 3/19/1999 in term of what the instant claims are entitled to. Note, petition (filed for late entry of Priority papers dated 1/27/2003) to which applicants refer, was dismissed.

Specification

5. The specification needs to be amended as per the desired claim for domestic priority either 35 U.S.C. 119(e) or 120. See MPEP 201.11.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 09840488, filed 4/23/01. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is very substantial overlap. For example, the species of claim 6 of instant application is the same as the second species of ref. '488 claim 5 species.

The difference between the two applications is that the ref. '488 claims are just slightly broader than those of the instant claims.

This would extend the monopoly of the instant application, if the ref. '488 is granted patent rights. Neither the Non-provisional U.S. Application Ser. No. 08843323, filed 4/14/1997 nor the instant application has any restriction/election.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7A. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 11, 12 of U.S. Patent No. 5593996. Although the conflicting claims are not identical, they are not patentably distinct from each other because the ref. '996 compounds of Formula I of claim 1 (see column 41, lines 30-63) wherein R₂ = H; R₁ = C₁-C₄-haloalkyl; R₄ = halogen atom; R₃ = phenyl optionally substituted by 1 to 3 substituents selected from halogen atoms, Nitro, C₁-C₄-alkoxy groups, substantially overlap with the instant claims.

The difference between the two applications is that the ref. '996 claims are broader than those of the instant claims.

This would extend the monopoly of the U.S.P. 5593996, if the instant application were granted patent rights.

8. **Additional issues to be resolved:**

It is noted that neither the specification nor the claims of U.S. Application Ser. NO. 08843323, filed 4/14/1997, can support the instantly claimed invention. This is because the application Ser. No. 08843323, filed 4/14/1997, upon which the priority claim for instant application has been made, does not exactly and definitely describe the instant variables. E.g. the L₁-L₅ variables as recited in ref. Application '323 in page 6 is limited to Fluorine, chlorine and -CH₃ groups. They do not represent either -O-alkyl or NO₂ groups are claimed herein. Therefore, this will raise additional issues related to addition

of "NEW SUBJECT MATTER" and issues related to 35 U.S.C. 112 paragraphs one & second respectively.

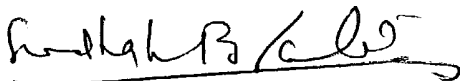
9. Other Applications: If there are any other closely related applications, applicants are requested to present the relevant serial numbers for further review and examination prior to allowance of the instant case.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is (571) 272-0671.

The examiner can normally be reached on 6:30 to 5:00 pm (Monday-Thursday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on (571) 272 0674 or Sr. Examiner Mr. Richard Raymond at (571) 272 0673 or Mr. James O. Wilson at (571) 272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sudhaker B. Patel, D.Sc. Tech.
April 23, 2004. 6/24/04



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MUKUND J. SHAH
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